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On: December 19, 2005

By: Richard D. Fuerle

Signature: 

Date: December 19, 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: David P. Lobeck

Examiner: Mendoza, Robert J.

Serial No.: 09/683,787

Group Art Unit: 3713

Filed: February 14, 2002

For: GOLF PRACTICE DEVICE

The Commissioner of Patents
and Trademarks
Alexandria, VA 22313

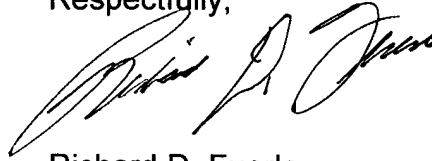
LETTER

Sir:

In response to the Notification of Non-Compliant Appeal Brief issued December 9, 2005, Apprllant herewith encloses three copies of his revised re-instated Appeal Brief.

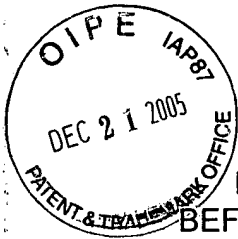
No oral hearing is requested.

Respectfully,

A handwritten signature in black ink, appearing to read 'Richard D. Fuerle', written in a cursive style.

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December 19, 2004
CASE DL01



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant: DAVID P. LOBECK

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RE-INSTATED BRIEF OF APPELLANT

Sir:

This is an appeal from the second Final Rejection of the Examiner, dated September 21, 2004, rejecting Claims 1 to 22.

(i) Real party In interest

The real party in interest is the inventor, David P. Lobeck.

(ii) Related appeals and interferences

There are no related appeals or interferences.

(iii) Status of claims

Claims 7 and 8 were canceled.

Claims 1 to 6 and 9 to 22 were rejected.

Claims 1 to 6 and 9 to 22 are appealed.

(iv) Status of amendments

No amendment was filed after the second Final Rejection.

(v) Summary of claimed subject matter

The independent claims are Claims 1, 13, and 18.

Claim 1

This claim is directed to a golf practice device. The device has a body that has vertical sides (Figure 1, numbers 3 and 4) that can be struck by a moving golf ball. The body has a head portion (Figure 1, number 3, Figure 4, number 27, paragraph 9, line 1, paragraph 14, line 2) and a base (Figures 1 and 2, number 4, Figure 4, number 28, paragraph 14, line 2). The head portion contains

- (A) at least one battery (Figures 2 and 3, number 13, paragraph 9, lines 8 to 9);
- (B) an electronic sound generator (a printed circuit board (PCB), Figure 2, number 11) that generates a sound when energized by the battery (paragraph 9, lines 14 to 15, and paragraph 11, lines 1 to 2);
- (C) a single sensor switch (Figures 2, number 18) that closes an electrical circuit connecting the battery to the electronic sound generator (paragraph 9, lines 9 to 11) when the device is struck by a golf ball coming from any direction (paragraph 3, line 3, paragraph 13, lines 3 to 4); and
- (D) an on-off switch (Figures 1 and 3, number 12) that enables the user of the golf practice device to turn the golf practice device on or off (paragraph 9, lines 4 to 8).

The base is either a pin (Figures 1 and 2, number 4) that can be pushed into the ground (paragraph 8, lines 1 to 2) or material made of small hooks

(Figure 4, number 28) that can be releasably attached to a fabric (paragraph 14, lines 1 to 3).

Claim 13

Claim 13 includes all of the elements of Claim 1, but also requires a speaker (Figures 2 and 3, number 9, paragraph 9, lines 14 to 16) and an electrical circuit (Figure 3, paragraph 10, lines 1 to 7) and is limited to a base that is a pin (Figures 1 and 2, number 4, paragraph 8, lines 1 and 2). In addition, Claim 13 requires that the circuit is closed only when both the on-off switch and the sensor switch are both closed (Figures 2 and 3, numbers 12 and 18, paragraph 10, lines 6 and 7).

Claim 18

Claim 18 is the same as Claim 13, except that the base is a material made of small hooks (Figure 4, number 28, paragraph 14, lines 1 to 4) instead of a pin.

The claims separately argued are: (a) Claim 4; (b) Claims 13 to 22; (c) Claims 5, 6, 15, and 16; (d) Claims 3, 18, and 22; (e) 20 and 21; and (f) 9, 14, and 19.

(a) Claim 4

Claim 4 depends from Claim 1 but also requires that the sides that are struck by the golf ball must be cylindrical (Figures 1 and 2, numbers 3 and 4, Figure 4, number 27).

(b) Claims 13 to 22

Claims 13 to 22 require that the circuit is closed only when both the on-off switch and the sensor switch are both closed (Figures 2 and 3, numbers 12 and 18, paragraph 10, lines 6 and 7)

(c) Claims 5, 6, 15, and 16

Claims 5 and 6 depend from Claim 1 and Claims 15 and 16 depend from Claim 13. Claims 5 and 15 require the sound that is generated to be that of a ball falling into a

cup (paragraph , lines). Claims 6 and 16 require the sound that is generated to be that of a human voice (paragraph , lines).

(d) Claims 3, 18, and 22

Claim 3 depends from Claim 1, Claim 18 is independent, and Claim 22 depends from Claim 18. Claims 3 and 18 require that the base is a material made of small hooks. The hooks can be releasably attached to a fabric (paragraph , lines) Claim 22 is a method claims that requires placing a golf practice device according to Claim 18 on a carpet, turning on the on-off switch, and putting golf balls at the device (paragraph , lines)

(e) Claims 20 and 21

Claims 20 and 21 depend from Claim 18. Claim 20 requires the sound that is generated to be that of a ball falling into a cup (paragraph , lines). Claim 21 requires the sound that is generated to be that of a human voice (paragraph , lines).

(f) 9, 14, and 19

Claims 9, 14, and 19 depend from Claims 1, 13, and 18, respectively. These claims require the sensor switch to be a metal spring mounted inside a metal ferrule, so that the metal spring contacts the metal ferrule when said golf practice device is struck by a golf ball.

(vi) Grounds of rejection to be reviewed on appeal

- I. Claims 1, 2, 4, 10 to 13, and 17 were rejected as unpatentable under 35 U.S.C. 103(a) over Lee in view of Pacheco.
- II. Claims 5, 6, 15, and 16 were rejected as unpatentable under 35 U.S.C. 103(a) over Lee in view of Pacheco.

- III. Claims 3, 18, and 22 were rejected as unpatentable under 35 U.S.C. 103(a) over Lee in view of Pacheco, further in view of Irving.
- IV. Claims 20 and 21 were rejected as unpatentable under 35 U.S.C. 103(a) over Lee in view of Pacheco, further in view of Irving.
- V. Claims 9, 14, and 19 were rejected as unpatentable under 35 U.S.C. 103(a) over Lee in view of Pacheco, further in view of Simms.

(vii) Argument

I. Rejection under 35 U.S.C. 103(a) over U.S. Patent No. 5,584,768 (Lee) in view of U.S. Patent No. 5,735,751 (Pacheco)

(A) Claims 1, 2, 4, 10 to 13, and 17

It is the Examiner's position that it would be obvious "to incorporate the teachings of Pacheco into the disclosed invention of Lee." Appellant does not agree. It is an object of Lee's invention "to provide a golf putting practice guiding device which is simple in structure, inexpensive to manufacture, ..." (column 1, lines 39 to 41). These objects cannot be achieved if the electronics of Pacheco are incorporated into Lee's device because Lee's device would no longer be "simple in structure" and "inexpensive to manufacture." It is not obvious to incorporate Pacheco's teachings into Lee's device when doing so would destroy the objects of Lee's invention by making Lee's invention both more complex and more expensive to manufacture.

Further, in column 3, lines 11 to 14, Lee states, "In addition, it is easy for the practicing golfer to putt the golf ball 109 into the real hole in the golf green since the practicing golfer practices with a target having a smaller size than that of the real hole." That sentence indicates that having a small target is a further object of Lee's invention. While Pacheco indicates that his device is "smaller than a regulation-sized golf hole" (column 2, lines 66 and 67), the incorporation of Pacheco's electronics into Lee's device would still significantly enlarge Lee's device and work against his object of having a

small target. For that reason also, it is not obvious to incorporate Pacheco's teachings into Lee's device. (Appellant is able to achieve a small target while incorporating electronics by placing the electronics in the head portion of the device and using a small pin. The references do not show that structure.)

It would further not be obvious to incorporate Pacheco's teachings into Lee's device unless it in some way improved Lee's device. Appellant sees no improvement to Lee's device that would result from such incorporation and, as explained in the previous paragraphs, such incorporation would, in Lee's view, make his device less desirable. Appellant further notes, for example, that in Lee's device the bell will sound upon even slight contact with the ball. However, in Pacheco's device there will be no sound unless the ball has enough energy to roll up the base a distance sufficient to depress a pressure bar. For that reason, Lee's device is more sensitive than Pacheco's device and Lee's device will be less sensitive if Pacheco's teachings of using sloped pressure bars is incorporated into it, and that is not an improvement.

Referring to Figure 5 of Pacheco, there are four switches 6, one for each pressure bar 3. Thus, it is not clear how these four pressure bars and four switches are to be incorporated into Lee. Lee's bell would have to be removed and so would his spring 3 as it would serve no purpose without the bell. Then Pacheco's pressure bars, which are crescent-shaped, would have to somehow be attached to Lee's plate 4. But the result would be almost the same as the original Pacheco device. The Examiner has not explained how Pacheco's teachings would be incorporated into Lee. It is Appellant's position that Pacheco and Lee are incompatible because Pacheco's four pressures bars and four sensor switches cannot be incorporated into Lee without completely changing Lee's device.

It is well settled that if a proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie*

obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). As argued in the previous paragraph, the incorporation of Pacheco's electronics into Lee's device would change the principles that Lee's device operates on and therefore such a combination would not be obvious.

All of Appellant's claims require that the sensor switch must close the electrical circuit when the golf practice device is struck by a golf ball coming from any direction. While Lee's bell will ring when a golf ball strikes his device coming from any direction, that is not true of Pacheco. Each of Pacheco's four pressure bar 3 (Figure 2) detects a golf ball coming from one of four directions. Referring to Figure 1 of Pacheco, if a golf ball rolls up base 2 in between two pressure bars 3, a pressure bar will not be depressed and there will be no audible sound. Moreover, in Figure 4 of Pacheco, each pressure bar 3 has a conductive material 8 on the bottom. In order to close the circuit, conductive material 8 must make contact at two locations with open circuits 6 (Figure 3). Thus, unless the golf ball pushes pressure bar 3 down evenly so that contact is made at both points, the circuit will not close. And, if the golf ball does not strike the center of the pressure bar, the pressure bar will not be pushed down evenly, contact will be made at only one point, and the circuit will not close. Thus, Pacheco's four sensor switches will not close his electrical circuit when the ball comes from any direction.

All of Appellant's claims require a single sensor switch while Pacheco requires four sensor switches. Pacheco does not disclose or suggest the use of a single sensor switch and Lee discloses no sensor switch. Of course, if a single sensor switch is used it must be capable of detecting a golf ball that comes from any direction, which Pacheco's sensor switches are not capable of doing.

All of Appellant's claims also require an on-off switch to prevent the device from making sounds when it is not being used. Figure 5 shows the electrical circuit for Pacheco. There are 4 switches 6 that are closed by the pressure bars, but there is no on-off switch. That means that if a golfer carries the Pacheco device around in his

pocket, it will constantly be going off every time a pressure bar is bumped, which will embarrass the golfer. Even if Pacheco's electronics is incorporated into Lee's device, the result will not fall within the scope of Appellant's claims because it will still have no on-off switch. All Appellant's claim limitations must be taught or suggested by the prior art and the cited prior art does not show an on-off switch.

Appellant's on-off switch completely shuts down the device so that it cannot operate, even when it is struck by a golf ball. It is clear from Appellant's circuit diagram (Figure 3) and his description that the on-off switch is in series (paragraph 10, lines 6 and 7) that on-off switch 12 shuts down the device. The Examiner believes that switches 6 in Figure 5 of Pacheco are "on-off" switches. There are four identical switches 6 in Figure 5 of Pacheco. Each switch 6 is connected to one of the four pressure bars 3, so that when a golf ball depresses one of the four pressure bars 3 it closes one of the four switches 6. Aside from the four switches 6, there are no other switches in the Pacheco device. All of Appellant's claims require an on-off switch that enables the user of the device to turn the device on or off. Pacheco's switches do not serve that purpose as they are always open unless closed by a golf ball.

The four switches 6 in Figure 5 of Pacheco perform the same function as the single sensor switch in Appellant's device, namely that they close an electrical circuit in response to a golf ball. There is no way to shut off or turn on Pacheco's device using a switch 6. The user cannot flip a switch 6 to shut off the device because switches 6 are always open unless a pressure bar 3 is depressed. As Pacheco says, "This conductive material (8) does not contact the P.C. board (7) when the flexible molded pressure bars (3) are not depressed." (Column 3, lines 14 to 16.) The only way to be sure that none of the four switches 6 is depressed is to put the device in a box, thereby preventing all contact with the pressure bars, and doing that does not involve the use of an on-off switch.

(B) Claims 1, 13, and 18

Appellant's independent Claims 1, 13, and 18 require two kinds of switches - a sensor switch and an on-off switch. Pacheco has only a single type of switch, a switch that closes when a ball depresses a pressure bar. That is the function performed by a sensor switch. Pacheco has no switch that performs the function of an on-off switch, which is to disable the device when it is not being used.

(C) Claim 4

Claim 4 does not stand or fall with the remaining claims in this rejection because Claim 4 requires that the "sides that are struck by said golf ball are cylindrical."

Webster's Ninth New Collegiate Dictionary defines "cylinder" as "the surface traced by a straight line moving parallel to a fixed straight line and intersecting a fixed planar closed curve" and "cylindrical" as "relating to or having the form or properties of a cylinder." In Lee, the ball strikes a spherical bell, not a cylinder, and in Pacheco the ball strikes a sloped pressure bar, not a cylinder.

(D) Claims 13 to 22

Claims 13 to 22 do not stand or fall with the remaining claims in this rejection because Claims 13 and 18 require that "said circuit is closed only when said on-off switch and said sensor switch are both closed." While Appellant believes that that requirement is implicit in the language used in Claim 1, the language used in Claim 13 leaves no doubt that two switches must be closed in order for the circuit to be closed. That is not true of Pacheco's circuit, where only a single switch must close in order to close the circuit.

II. Rejection under 35 U.S.C. 103(a) over U.S. Patent No. 5,584,768 (Lee) in view of U.S. Patent No. 5,735,751 (Pacheco)

Claims 5, 6, 15, and 16

The Examiner argues that it would have been obvious "to incorporate the sound of a ball falling into a cup or a human voice." Appellant does not agree. If Pacheco's

electronics were incorporated into Lee, the electronically-generated sound would be that of a bell, just as in Lee. No references were cited that use the sounds claimed by Appellant and there is no support for the Examiner's assertion that using such sounds would be obvious. The Examiner argues that "the selection of sound is merely a matter of design choice" but there is a certain amount of cleverness involved in having the device make the sound of a ball whirling around a cup then hitting the bottom of the cup or having it say, "Great shot!"

III. Rejection under 35 U.S.C. 103(a) over U.S. Patent No. 5,584,768 (Lee) in view of U.S. Patent No. 5,735,751 (Pacheco) further in view of U.S. Patent No. 6,259,622 (Irving)

Claims 3, 18, and 22

Lee and Pacheco have been discussed. Irving was cited to show a base of material made of small hooks that can be releasably attached to a fabric. The Examiner seems to be suggesting that it would be obvious to take the "Velcro" off the bottom of Irving's tee and stick it on to the bottom of Pacheco's device in order to attach Pacheco's device to a carpet. However, Pacheco expressly states (column 2, lines 38 to 40) that one of the objects of his invention is "to allow golfer to move target away from previously putted balls by simply sliding the target to a new location with his putter." The "Velcro" would hold Pacheco's device to the carpet, preventing Pacheco from achieving this object of his invention. Therefore, it is not obvious to combine Irving with Pacheco.

An object of Lee's invention is to provide a putting aid that has "a supporting pin for securing the device into the ground such as a golf green" (column 1, lines 30 to 33). That object of Lee's invention would also be defeated by combining Irving with Lee and it is therefore not obvious to do so.

In addition, the “Velcro” (82) in Irving is not used to attach the device to a fabric. Rather, it is used to attach the bottom of the tee to platform 42. Appellant’s Claims 3, 18, and 22 require that the base of the device must be made of small hooks, so that the “golf practice device can be releasably attached to a fabric.” That is not taught by Irving, who does not teach putting “Velcro” at the base of his platform 42.

Furthermore, both Lee and Pacheco have devices at which the golfer puts the ball. Irving has an automatic tee from which the ball is hit. The references are directed at entirely different problems and a person skilled in the art, seeking to make a device which the golfer tries to hit with a ball would not look to a device that re-supplies balls to be hit when a switch is stepped on.

IV. Rejection under 35 U.S.C. 103(a) over U.S. Patent No. 5,584,768 (Lee) in view of U.S. Patent No. 5,735,751 (Pacheco) further in view of U.S. Patent No. 6,259,622 (Irving)

Claims 20 and 21

Lee, Pacheco, and Irving have already been discussed. Claims 20 and 21 further limit the scope of Claim 18, from which they depend. Claim 18, from which Claims 20 and 21 depend, was discussed in the preceding paragraphs and is believed to more than adequately distinguish over these references. Furthermore, this rejection is similar to the rejection of Claims 5, 6, 15, and 16 and Appellant’s comments as to that rejection also apply to this rejection.

V. Rejection under 35 U.S.C. 103(a) over U.S. Patent No. 5,584,768 (Lee) in view of U.S. Patent No. 5,735,751 (Pacheco) further in view of U.S. Patent No. 4,757,194 (Simms)

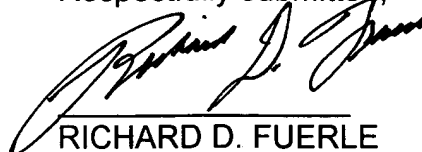
Claims 3, 18, and 22

Lee and Pacheco have been discussed. Simms is cited to show “a sensor switch that is a spring that makes contact with a ferrule when the sensor switch senses an application of force (col. 7:21-34).” (Page 5 of Final Rejection) The Simms device is complicated, large, and completely unsuited for installation into a golf practice device. It detects pressure by means of optical connections using a beam splitter and a lens to the measure changes in reflected light, not by making an electrical connection between a ferrule and a spring, as required in Appellant’s claims. It is intended for use in “sensing and signalling [sic] of a patient’s impending incontinence.” (Column 1, lines 32 to 34.) The Simms device has nothing whatsoever to do with the game of golf and should not be used in this rejection as it is non-analogous art.

There is a ferrule 26 and a spring 92 in Simms, but there is no electrical connection between them. Indeed, they are not even used together in the same embodiment. Ferrule 26 is used in the embodiment of Figures 1 to 4 and spring 92 is used in the embodiment of Figures 6A, 6B, 7A, and 7B, so they are not even used together.

For these reasons, it is submitted that Appellants’ invention is not obvious over the references cited. The Board is therefore requested to reverse the Examiner and allow Claims 1 to 6 and 9 to 22.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Richard D. Fuerle", written over a horizontal line.

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December 19, 2005

(viii) Claims appendix

1. A golf practice device comprising a body that has vertical sides that can be struck by a moving golf ball, said body having a head portion and a base, where
 - (I) said head portion contains
 - (A) at least one battery;
 - (B) an electronic sound generator that generates a sound when energized by said battery; and
 - (C) a single sensor switch that closes an electrical circuit connecting said battery to said electronic sound generator when said golf practice device is struck by a golf ball coming from any direction; and
 - (D) an on-off switch that enables the user of said golf practice device to turn said golf practice device on or off; and
 - (II) said base is selected from the group consisting of a pin that can be pushed into the ground and material made of small hooks that can be releasably attached to a fabric.
2. A golf practice device according to Claim 1 wherein said base is a pin that can be pushed into the ground.
3. A golf practice device according to Claim 1 wherein said base is a material made of small hooks, whereby said golf practice device can be releasably attached to a fabric.
4. A golf practice device according to Claim 1 wherein said sides that are struck by said golf ball are cylindrical.
5. A golf practice device according to Claim 1 wherein said sound is that of a ball

falling into a cup.

6. A golf practice device according to Claim 1 wherein said sound is a human voice.
7. (Canceled)
8. (Canceled)
9. A golf practice device according to Claim 1 wherein said sensor switch is a metal spring mounted inside a metal ferrule, so that said metal spring contacts said metal ferrule when said golf practice device is struck by a golf ball.
10. A golf practice device according to Claim 1 wherein said display generator is an integrated circuit for generating an electrical signal and a speaker for converting said electrical signal into sound.
11. A method of improving putting accuracy comprising inserting the pin of a golf practice device according to Claim 2 into a putting green and putting golf balls at said golf practice device.
12. A method of improving putting accuracy comprising placing a golf practice device according to Claim 3 on a carpet and putting golf balls at said golf practice device.

13. A golf practice device comprising a body that has vertical sides that can be struck by a moving golf ball, said body having a head portion and a base, where
- (I) said head portion contains
- (A) an on-off switch that enables the user of said device to turn said device on and off;
 - (B) at least one battery;
 - (C) an integrated circuit chip programmed to generate an electrical signal when energized by said battery;
 - (D) a speaker that generates a sound when energized by said electrical signal;
 - (E) a single sensor switch that closes an electrical circuit connecting said battery to said integrated circuit chip when a side of said golf practice device is struck by a golf ball coming from any direction; and
 - (F) an electrical circuit connecting said battery, said on-off switch, said sensor switch, said integrated circuit chip, and said speaker, whereby said circuit is closed only when said on-off switch and said sensor switch are both closed; and
- (II) said base is a pin that can be pushed into the ground.
14. A golf practice device according to Claim 13 wherein said sensor switch is a metal spring mounted inside a metal ferrule, so that said metal spring contacts said metal ferrule when said golf practice device is struck by a golf ball.

15. A golf practice device according to Claim 13 wherein said sound is that of a ball falling into a cup.
16. A golf practice device according to Claim 13 wherein said sound is that of a human voice.
17. A method of improving putting accuracy comprising inserting the pin of a golf practice device according to Claim 13 into a putting green, turning on said on-off switch, and putting golf balls at said device
18. A golf practice device comprising a body that has vertical sides that can be struck by a moving golf ball, said body having a head portion and a base, where
 - (I) said head portion contains
 - (A) an on-off switch that enables the user of said device to turn said device on and off;
 - (B) at least one battery;
 - (C) an integrated circuit chip programmed to generate an electrical signal when energized by said battery;
 - (D) a speaker that generates a sound when energized by said electrical signal;
 - (E) a single sensor switch that closes an electrical circuit connecting said battery to said integrated circuit chip when a side of said golf practice device is struck by a golf ball coming from any direction; and

(F) an electrical circuit connecting said battery, said on-off switch, said sensor switch, said integrated circuit chip, and said speaker, whereby said circuit is closed only when both said on-off switch and said sensor switch are closed; and

(II) said base is a material made of small hooks that can be releasably attached to a fabric.

19. A golf practice device according to Claim 18 wherein said sensor switch is a metal spring mounted inside a metal ferrule, so that said metal spring contacts said metal ferrule when said golf practice device is struck by a golf ball.
20. A golf practice device according to Claim 18 wherein said sound is that of a ball falling into a cup.
21. A golf practice device according to Claim 18 wherein said sound is that of a human voice.
22. A method of improving putting accuracy comprising placing a golf practice device according to Claim 18 on a carpet, turning on said on-off switch, and putting golf balls at said device.

(ix) Evidence appendix

None

(x) Related proceedings appendix

None